

### **REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1-17, 20, and 21 have been cancelled without prejudice or disclaimer.

New claims 25-36 have been added.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 18, 19, and 22-36 are now pending in this application. Claims 22-24 have been withdrawn from consideration.

#### **Priority**

The Office Action did not include a clear acknowledgement of Applicant's claim for foreign priority under 35 U.S.C. § 119. In particular, the section in the Office Action Summary for acknowledging Applicant's claim for foreign priority included boxes checked to indicate that all copies of certified copies of Applicant's priority documents had been received but did not include a checked box to acknowledge Applicant's claim for foreign priority (the first box next to "12") was inadvertently not checked).

Applicant respectfully requests that the Office acknowledge Applicant's claim to foreign priority, such as by checking all of the boxes in the Office Action Summary, in the next Office correspondence.

#### **Rejection under 35 U.S.C. § 103**

Claims 1-21 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,536,573 to Rubner *et al.* (hereafter "Rubner") in view of U.S. Patent No. 5,225,495 to Han *et al.* (hereafter "Han"). This rejection is respectfully traversed.

Rubner discloses a multilayer thin film of electrically conductive polymers. See Rubner at col. 1, lines 14-16. Rubner discloses that the films are formed by alternating deposition in which a substrate is dipped into a dilute solution of p-type doped polymer, such as a p-doped conjugated polymer, rinsing the substrate, and then dipping the substrate into a dilute solution containing a polyanion or a water soluble, non-ionic polymer. See Rubner at col. 3, lines 30-43; col. 4, line 67, to col. 5, line 6; col. 6, lines 56-60.

However, Rubner does not disclose or suggest a method to coat a metal element with a self-assembled coating layer comprising, among other things, electrochemical anodic polymerisation starting from a solution of a monomer of an inherently conductive polymer and at least one dopant, as recited in claim 18. Rubner is silent in regard to such a step and does not disclose or suggest all of the features of claim 18. Claims 19 depends from claim 18.

Further, the Office states on page 3 of the Office Action that Rubner does not disclose a method of application using a solution of a monomer or a dopant. The Office cites Han to address this deficiency of Rubner.

Han discloses a process of forming a composite of a film of conducting conjugated polymer by oxidative coupling of a conjugated backbone monomer on a substrate by contacting a substrate with a solution to form the film. See Han at col. 2, line 38, to col. 3, line 14.

However, Han fails to remedy the deficiencies of Rubner because Han also does not disclose or suggest the process recited in claim 18. Similarly to Rubner, Han discloses a process of depositing a film by dipping, not by electrochemical anodic polymerisation, as recited in claim 18. As a result, the combination of Rubner and Han does not disclose or suggest all of the features of claim 18.

The Office argues on pages 3-4 of the Office Action that it would have been obvious to one of ordinary skill in the art to have used “conventional” coating methods for the films disclosed by Rubner and Han and that it would have been obvious to one of ordinary skill in the art to have used “conventional charge-based polymerization methods.”

However, the Office has not provided any facts or evidence that such methods are known in the art. Applicant respectfully requests that the Office provide prior art to show these features or withdraw the rejection. See MPEP § 2144.03.

Nor has the Office provided any rationale why it would have been obvious to modify the particular processes of Rubner and Han even if such a process has been shown to have been known in the art, if such a process in fact was known in the art at the time Applicant's invention was made. In other words, the Office appears to assume that it would have been obvious to have made such modifications without first considering the state of the art as a whole, such as whether any such prior art references would teach against one another and whether the modifications would cause the processes of Rubner and Han to be unsuitable for their intended uses or would change the principle of operations of these processes. Instead, the Office appears to impermissibly rely on the disclosure of Applicant's own invention in formulating a conclusion of obviousness without first considering facts and evidence provided in the art, which demonstrates hindsight by the Office.

For at least the reasons discussed above, reconsideration and withdrawal of this rejection is respectfully requested.

#### **New Claims**

New claims 25-36 have been added. Claims 25-36 depend from claim 18 and are allowable over the prior art for at least the reasons discussed above and for their respective additional recitations. Applicant respectfully submits that claims 25-36 are drawn to the elected specie.

#### **Conclusion**

Applicant submits that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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